

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

June 10, 1997

Paper No. 29

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rainmaker Marketing, Inc.

v.

Thomas E. Kane

Opposition No. 93,524
to application Serial No. 74/349,564
filed on January 19, 1993

Susan Freya Olive of Olive & Olive, P.A. for Rainmaker
Marketing, Inc.

Karen K. Hammond of Porter, Wright, Morris & Arthur for
Thomas E. Kane.

Before Rice, Cissel and Seeherman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

Thomas E. Kane applied to register the mark shown below
for "legal marketing services," in Class 35.



By subsequent Examiner's amendment, his services were described as "legal marketing consultation services," and the classification was changed to Class 42. Also by Examiner's amendment, the word "GROUP" was disclaimed apart from the mark as shown. Use of the mark since April 1, 1992 and use in interstate commerce since August 22, 1992 were claimed in the application as filed.

Following publication of the mark in accordance with Section 12(a) of the Lanham Act, Rainmaker Marketing, Inc. timely filed a notice of opposition under Section 13. As grounds for opposition, opposer alleged that since July 19, 1985, which is long before applicant's claimed date of first use, opposer has been engaged in interstate commerce under the marks "RAINMAKER" and "RAINMAKER MARKETING, INC." and the trade name "RAINMAKER MARKETING, INC."; that the services with which opposer's name and marks have been used since that time include marketing and consultation services for the legal community, and lawyer referral services; and

that applicant's mark, as used in connection with the services set forth in the application, so resembles opposer's marks and trade name that confusion is likely.

In answer to the notice of opposition, applicant denied the salient allegations regarding opposer's use and denied that confusion is likely. Further, applicant asserted laches, estoppel and acquiescence as affirmative defenses.

A trial was conducted in accordance with the Trademark Rules of Practice, and testimony, evidence and briefs were submitted by the parties. No oral hearing was requested.

The record includes the file of the opposed application, of course, as well as applicant's responses to opposer's requests for admissions; applicant's answers to opposer's interrogatories, some of which are subject to a confidentiality agreement between the parties; a list¹ of third-party registrations and a third-party application for marks which purportedly consist of or include the word "RAINMAKER"; copies of three different publications with titles which include the term "Rainmaker" or "Rainmaking;" and the testimony of James O'Herron, opposer's president.

The pleaded affirmative defenses were not mentioned after the answer was filed, and no evidence relating to them was introduced, so even if applicant did not intend to

¹This list was the subject of a motion to strike, which was denied by the Board on December 20, 1995. See discussion at page 10, infra.

withdraw them, he has not established that he is entitled to relief based on the affirmative defenses he pleaded.

Accordingly, the issues for our resolution in this proceeding are priority and likelihood of confusion.

The record shows that opposer is a full service advertising and marketing agency which works exclusively with legal professionals. Mr. O'Herron's testimony establishes that opposer provides a wide range of services to lawyers and law firms, including not just advertising, but also consulting, training, planning and marketing services as well. For example, opposer identifies appropriate marketing activities for its clients, attempting to help the clients enhance their images and thereby maximize clients' abilities to get their own clients to hire them for wider ranges of legal work. Opposer conducts retreats and marketing seminars, as well as providing one-on-one consultations with respect to the marketing of legal services. Opposer conducts market surveys and competitive analyses for its clients, creates annual marketing plans for them, and provides a range of media planning services, including the design and placement of advertisements. Opposer produces and distributes widely a quarterly newsletter which both promotes opposer's services and informs clients and potential clients about issues in legal marketing and advertising which could be important to them.

Opposer has established its priority with testimony and evidence that it used its marks and trade name before

applicant used the mark he seeks to register. Mr. O'Herron's testimony is clear that promotion of opposer's services under the name "RAINMAKER MARKETING, INC." and the marks "RAINMAKER MARKETING" and "RAINMAKER" has been continuous and extensive since July 19, 1985.

Applicant neither claimed nor proved use of the mark he seeks to register in connection with his services prior to the 1992 date set forth in the original application, but his responses to opposer's discovery requests support his claim of use in 1992.

In view of opposer's clear priority, we turn to the question of whether confusion is likely. Based on the record before us, we hold that applicant's mark, as used in connection with the services set forth in the application, so resembles opposer's trade name and marks, which opposer has used in connection with its services, as to be likely to cause confusion.

At the outset of our discussion of this issue, we must explain exactly what we consider to be applicant's services. As noted above, the application as filed identified the services as "legal marketing services." At the request of the Examining Attorney, applicant amended it to add the word "consultation," so the identification clause in the application thus became "legal marketing consultation services."

On March 27, 1995, well after the close of opposer's testimony period and two days before applicant's testimony

period was scheduled to close, applicant filed a request for remand to the Examining Attorney for consideration of an amendment, asserting that the proposed amendment narrowed his identification of services and would avoid any overlap with the services rendered under opposer's marks. The proposed amendment would have changed the recitation of applicant's services in the application to read "education, training and planning services to law firms regarding the development and enhancement of client relationships." Both parties filed briefs on the motion to remand the application, and applicant filed a reply brief.²

On August 9, 1995, the Board noted that applicant's request to remand the application to the Examining Attorney for consideration of the proposed amendment to the recitation of services was improper, in that the Board, rather than the Examining Attorney, had the sole discretion in an opposition proceeding to determine whether to permit such an amendment. The Board also noted that the proposed amendment was untimely because it was filed at the end of applicant's testimony period, rather than prior to trial. The Board acknowledged that opposer had not objected to the amendment on the ground that it was untimely, however, and in fact had argued against the amendment on its merits.

²The Board has exercised its discretion and has considered the reply brief, but opposer objected to the exhibit applicant submitted with it. The submission of the exhibit in this manner does not make it part of the evidentiary record in this proceeding, but even if we were to consider the exhibit, it would not alter our ruling.

Accordingly, the request to amend was not denied as untimely. Instead, as is the normal practice when an applicant seeks, without the consent of opposer, to avoid a finding of likelihood of confusion by limiting its identification of goods or services, the Board deferred the ruling on the acceptability of the proposed amendment until final hearing.

Trademark Rule 2.71(b) permits amendment to clarify or limit the identification of services, but expansions or additions are not allowed. We deny applicant's request to amend the identification of his services because the proposed amendment impermissibly broadens, rather than narrows, the services as they are presently identified in the application. Although the proposed amendment is plainly an attempt by applicant to avoid the appearance of any overlap between the services rendered under his mark and those rendered under opposer's mark, (as admitted in his brief on the motion, p.2), it includes services not encompassed within the existing language. The references to "education" and "training," as well as to the "development and enhancement of client relationships," are outside the scope of what could reasonably be understood to constitute "legal marketing consultation services." Training law firm personnel how to enhance their relationships with clients may have a positive effect on the level of sales of the firm's legal services, but it would not be commonly understood to be encompassed within the term "legal

marketing consultation services." Similarly, while consulting with law firm personnel may result in their education, the term "legal marketing consultation services" would not ordinarily be understood to refer to whatever education results from such consultation, but rather to the activities of conferring with people at the firm and advising them with respect to how to promote the sale of the services the firm provides.

The record supports applicant's claim that he renders legal marketing consultation services to law firms. In any event, our resolution of the issues on appeal would not change even if the proposed amendment were allowed. As opposer points out, in addition to consulting with law firms regarding the marketing of their legal services, opposer also uses its name and marks in connection with teaching them how to develop and improve their relationships with their clients.

Returning, then, to the issue of likelihood of confusion between applicant's mark, as used in connection with "legal marketing consultation services," and opposer's trade name and marks, as used in connection with opposer's services, as we noted above, confusion is likely because opposer's trade name and opposer's marks are similar to the mark applicant seeks to register and the services rendered by applicant and opposer are in part identical and otherwise are closely related.

Our primary reviewing court, in the landmark case of *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), identified the possible factors to which the evidence in a particular case might relate in determining whether confusion is likely. The factors most relevant to the instant case are the similarity of the trade name and marks in their entirety, the relationship between the services rendered under the marks, and whether actual confusion has occurred.

While the trade name and marks in the instant case are not identical, they are similar when they are considered in their entirety. Opposer pleaded and proved the use of "RAINMAKER" alone, as well as with the words "MARKETING" and "INC."

It is well settled that it is not improper, under appropriate circumstances, i.e., where a rational basis for doing so exists, to give more significance to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. In *re National Data Corp.*, 753 F.2d 1056, 244 USPQ 749 (Fed. Cir. 1985). Just as opposer's mark "RAINMAKER" is the dominant component of opposer's mark and trade name, "RAINMAKER MARKETING, INC.," it is the word "RAINMAKER" which plays the dominant role in creating the commercial impression of applicant's mark. The descriptive, and hence disclaimed, word "GROUP" has no more source-identifying significance than the "MARKETING, INC." component of opposer's mark and

trade name, "RAINMAKER MARKETING, INC." In applicant's mark, the graphic representation of what appear to be storm clouds is less significant than the word "RAINMAKER."

In any event, the cloud design only reiterates or emphasizes the same suggestion of making rain that the word itself conveys. "RAINMAKER" is suggestive as used in connection with these activities because a rainmaker is a person who brings the rain which is necessary in order to grow crops. The analogy is that one who brings business to the firm makes rain. The suggestive term "RAINMAKER" is the word that clients and prospective clients of the services of both parties would be most likely to recall and to use when referring to the services that each renders under these marks. Applicant's mark, considered as a whole, is substantially similar in overall commercial impression to opposer's mark "RAINMAKER" and opposer's mark and trade name "RAINMAKER MARKETING, INC."

We are not persuaded by applicant's argument that because of the suggestive nature of the word "RAINMAKER" and its use by third parties in connection with related activities, the term is weak in source-identifying significance. To begin with, the argument that "RAINMAKER" is weak because of extensive third-party use in marks for related services is unsupported by evidence. As the Board's December 20, 1995 action explaining the ruling on the motion to strike the list of third-party registrations noted, although the list has not been stricken, its persuasive

value is extremely limited because the registrations themselves are not of record. Moreover, even if applicant had properly made the registrations and the application of record in this case, these materials would not be evidence that the marks therein are in use, so they could hardly be persuasive of the proposition that use of marks including or consisting of the word "RAINMAKER" has been so pervasive that the consumers of the services in question here look to other components of such marks in order to distinguish among them. As we have often reiterated, the existence on the register of marks which might appear to be likely to cause confusion cannot aid an applicant in registering yet another mark which is likely to cause confusion or mistake or to deceive. In re Mayco Mfg., 192 USPQ 573 (TTAB 1976).

Applicant also argues that other evidence he introduced of the use of the term "RAINMAKER" shows that opposer's mark is weak in source-identifying significance. As we noted above, the term has suggestive significance as used in connection with the services of the parties to this proceeding, but the examples provided by applicant in support of this contention do not show adoption or use of the word by third parties as trademarks or as service marks in connection with these kinds of services. The record supports the conclusion that in the field of marketing legal services, only applicant and opposer use marks which consist of or incorporate the term. We thus have no basis for

adopting applicant's argument that the word is weak in terms of source-identifying significance.

Notwithstanding applicant's contentions to the contrary, confusion is clearly likely when the similar marks and name involved in this case are used in connection with what are essentially the same services, sold to the same firms through the same channels of trade.

Our finding that confusion is likely is not based on opposer's allegation that actual confusion has occurred. The testimony of Mr. O'Herron relating to this issue is not clear proof that confusion has actually taken place. It is not clear, for example, what the factual basis was for Mr. O'Herron's conclusion that the exhibit manager at the North Carolina Bar Association meeting was confused. The other incident argued to be proof that confusion has actually taken place concerned a telephone inquiry from the representative of a legal publication. It is well settled, however, that making an inquiry may not show confusion at all. That the exhibit manager inquired as to whether the marks indicated that the services were provided by a single source does not conclusively establish that he mistakenly assumed that they did. Inquiry does not necessarily indicate confusion. See *Pump Inc. v. Collins Management Inc.*, 15 USPQ 1716 (DC Mass. 1990) and cases cited therein.

Opposer has also asserted that if applicant were actually as deeply involved in the field of marketing legal services as his advertising indicates he is, then he surely must have been aware of opposer's name and marks. The testimony of Mr. O'Herron and

the evidence of record in connection with it concerning the scope and extent of opposer's advertising and promotion of its business under its trade name and service marks does show that opposer and its marks are well known in this field. Opposer argues that in view of this fact, the Board should infer that applicant acted in bad faith and copied opposer's mark in an attempt to trade off opposer's good reputation in this field.

While this argument does make sense in view of the facts of record here, we do not need to engage in such speculation in order to hold for opposer. Intent to copy is not a necessary element in establishing that confusion is likely. Intent could be a factor if the issue of likelihood of confusion were in doubt, but we have no doubt on that issue in this case.

In a similar sense, we are not persuaded by applicant's argument that confusion is not likely in this case because the purchasers of the services of applicant and opposer are sophisticated law firm professionals. It is clear from the record that these services are not inexpensive purchases made casually by ordinary consumers. Even highly educated and sophisticated attorneys, however, are not immune from confusion when the marks are as similar as these marks are and the services with which they are used are virtually identical. In re General Electric Company, 180 USPQ 542 (TTAB 1973).

In summary, opposer has established that confusion is likely in view of the fact that applicant's mark is very similar to the marks and trade name which opposer has previously used in connection with services which are substantially the same as the services set forth in the application. Accordingly, the opposition is sustained and registration to applicant is refused.

J. E. Rice

R. F. Cissel

E. J. Seeherman
Administrative Trademark Judges
Trademark Trial & Appeal Board